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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/758,595

01/16/2004

Katsukuni Nitta

NITTA1

5392

1444 7590 09/04/2008  
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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1794

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/758,595	<b>Applicant(s)</b> NITTA ET AL.	
	<b>Examiner</b> LAWRENCE D. FERGUSON	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment filed August 8, 2008.

Examiner regrets the untimely reopening of the case and withdraws the previous rejections to further prosecute the claimed invention. Claims 1-28 are pending in this case.

### **Claim Rejections – 35 USC 112**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9-10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. In claim 9, the phrase, “formed on the thermoplastic resin film” is indefinite. It is unclear which thermoplastic resin film Applicant is referring to, as there are two thermoplastic resin films, which are attached to both faces of a light shielding layer.

In claim 12, the phrase, “wherein the light-shielding layer comprises vapor deposited aluminum on the thermoplastic resin film” is indefinite. It is unclear which

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thermoplastic resin film Applicant is referring to, as there are two thermoplastic films, which are attached to both faces of a light shielding layer.

***Claim Rejections – 35 USC § 102(b)***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 7, 13-16 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Akao (U.S. 4,469,741).

Akao discloses a film having thermoplastic resin films (4,5) attached to both faces of a porous sheet (6) (column 2, lines 35-45 and Figure 2) where each of the layers 3 to 8 may contain light shielding substances (column 6, lines 63-68) which includes sheet 6. In claim 1, the phrase, "for forgery prevention" is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the

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prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Concerning claims 2-3 and 7 because Akao discloses a structure in which a thermoplastic resin film is attached to both faces of a light shielding layer, it is inherent for the light shielding layer to have shading that is invisible by reflected light but visible by transmitting light and for the light part of the material to have a dot ratio of from 5-70 percent. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In *re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of a newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. Additionally, anticipation by a prior art reference does not require that the reference recognize the inherent properties that may be possessed by the prior art reference. See *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633 (Fed. Cir.) (1987).

Concerning claims 13-16, adhesive layers (3) include thermoplastic resins (column 3, lines 1-5) and can be construed as a first thermoplastic layer and an additional thermoplastic layer. Additionally, layer 4 and/or 5 can be construed as an additional thermoplastic layer(s) laminated on the surface of the first thermoplastic layer, where layers 4 and 5 can comprise polyethylene terephthalate (column 2, lines 40-51).

Concerning claim 19, the film of Akao is laminated (column 1, lines 5-8, column 2, lines 5-9 and column 7, line 24).

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In all of the above mentioned claims, the instant invention includes the preamble language of, "a forgery-preventing film". Although the instant preamble has been considered, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the preamble merely recites the intended use of a structure, and the body of the claim is able to stand alone; therefore, although the preamble has been considered, the preamble language has not been accorded patentable weight.

***Claim Rejections – 35 USC § 103(a)***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4-5, 8, 11-12, 18 and 21-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akao (U.S. 4,469,741).

Akao is relied upon for claim 1 as above. Akao does not disclose shading percentage of the light shielding material or light transmittance as disclosed in claims

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4-5 and 8. Although Akao does not specifically disclose the proportion of the shading percentage of the light shielding material or light transmittance, shading and light transmittance are an optimizable feature. It would have been obvious to one of ordinary skill in the art to optimize the shading of the light shielding material and light transmittance because discovering the optimum or workable range involves only routine skill in the art. The light shielding material shading and transmittance directly affects the aesthetics of the multilayer material. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215. Additionally, because the light shielding layer comprising substances such as aluminum powder can be used appropriately, depending on the purpose for which the sheet is used, (column 6, line 63 through column 7, line 2), in this case shading, it is reasonable to conclude the darker shaded, where any shading would be considered darker, would include at least 90 percent darker shading. Because shading does not necessarily inhibit all light transmittance, it is also reasonable to expect less than or about 5 to 12 percent light transmittance from the multilayer structure, which is similar to the structure that is claimed.

Concerning claim 11, the phrase, "formed by applying from 2 to 10 g/m<sup>2</sup> of an adhesive that contains from 5 to 75 weight percent of white filler and/or colored pigment" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re*

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Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given little patentable weight in product claims.

Concerning claims 12, the light shielding layer comprises aluminum (column 6, lines 63-66) which is on thermoplastic resin films (4,5) (Figure 2) and further is on the adhesive layers (3) which also include thermoplastic resins (column 3, lines 1-5). The phrase "vapor deposited" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given little patentable weight in product claims.

Concerning claim 18, the phrase, "outermost thermoplastic resin film is printable in any mode of electrophotography" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. It is reasonable to expect the outermost thermoplastic resin film of Akao is printable in any mode of electrophotography, sublimation thermal transferring, melt thermal transferring, direct thermal transferring or inkjet printing.

Concerning claims 21-28, Akao discloses a laminated sheet or structure (column 1, lines 5-9) which is construed as having the form of a card, security, certificate, bill, ticket, check, license or label, where Akao teaches the material can have a varied shape, depending upon the article (column 1, lines 5-15).

In all of the above mentioned claims, the instant invention includes the preamble language of, "a forgery-preventing film". Although the instant preamble has been considered, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the preamble merely recites the intended use of a structure, and the body of the claim is able to stand alone; therefore, although the preamble has been considered, the preamble language has not been accorded patentable weight.

***Claim Rejections – 35 USC § 102(b)***

9. Claims 1-3, 6-7, 13-17 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Akao (U.S. 4,653,640).

Akao discloses a film having flexible sheet layers formed of thermoplastic resin laminated on both sides of a thermoplastic resin layer (column 1, lines 41-52 and column 4, lines 55-65) where one or more of the layers are light shielding layers (column 1, lines 50-52 and column 10, lines 30-34). In claim 1, the phrase, "for forgery prevention" is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art

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structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Concerning claims 2-3 and 7 because Akao discloses a structure in which a thermoplastic resin film is attached to both faces of a light shielding layer, it is inherent for the light shielding layer to have shading that is invisible by reflected light but visible by transmitting light and for the light part of the material to have a dot ratio of from 5-70 percent. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In *re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of a newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. Additionally, anticipation by a prior art reference does not require that the reference recognize the inherent properties that may be possessed by the prior art reference. See *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633 (Fed. Cir.) (1987).

Concerning claim 6, the light shielding properties may be applied by printing (column 10, lines 42-44).

Concerning claims 13-16, one of the two thermoplastic sheet layers is applied with a thermoplastic adhesive layer (column 1, lines 41-52), where the adhesive layer is construed as a first thermoplastic layer and the flexible sheet layer it is attached to is

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construed as an additional thermoplastic layer, which can comprise polyester or polyethylene terephthalate (column 4, line 58 through line 20).

Concerning claim 17, Akao discloses a colored (pigment) coating paper can be laminated on one or more of the layer (column 10, lines 35-44) which includes the outermost thermoplastic resin film.

Concerning claim 19, the film of Akao is laminated (column 1, lines 5-8, column 2, lines 5-9 and column 7, line 24).

In all of the above mentioned claims, the instant invention includes the preamble language of, "a forgery-preventing film". Although the instant preamble has been considered, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the preamble merely recites the intended use of a structure, and the body of the claim is able to stand alone; therefore, although the preamble has been considered, the preamble language has not been accorded patentable weight.

### ***Claim Rejections – 35 USC § 103(a)***

10. Claims 4-5, 8-12, 18 and 21-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akao (U.S. 4,653,640).

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Akao is relied upon for claim 1 as above. Akao does not disclose shading percentage of the light shielding material or light transmittance as disclosed in claims 4-5 and 8. Although Akao does not specifically disclose the proportion of the shading percentage of the light shielding material or light transmittance, shading and light transmittance are an optimizable feature. It would have been obvious to one of ordinary skill in the art to optimize the shading of the light shielding material and light transmittance because discovering the optimum or workable range involves only routine skill in the art. The light shielding material shading and transmittance directly affects the aesthetics of the multilayer material. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215. Additionally, because a metal foil light shielding layer may be deposited on one or more of the layers (column 10, lines 35-40) , it is reasonable to conclude a darker shaded, where any shading would be considered darker, would include at least 90 percent darker shading. Because shading does not necessarily inhibit all light transmittance, it is also reasonable to expect less than or about 5 to 12 percent light transmittance from the multilayer structure, which is similar to the structure that is claimed.

Concerning claim 9-10, a light shielding layer is a metallic color print formed on a thermoplastic resin film, having a thickness of 5 microns (column 10, lines 35-44) where metallic is construed as magnetic material. In claim 9, the phrase, "a mode of offset or gravure printing" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

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unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given little patentable weight in product claims.

Concerning claims 11-12, a light shielding layer comprising aluminum is deposited on a thermoplastic resin film (column 10, lines 35-44). In claims 11 and 12, the phrases, “formed by applying from 2 to 10 g/m<sup>2</sup> of an adhesive that contains from 5 to 75 weight percent of white filler and/or colored pigment” and “vapor deposited” introduce process limitations to the product claims. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given little patentable weight in product claims.

Concerning claim 18, the phrase, “outermost thermoplastic resin film is printable in any mode of electrophotography” constitutes a ‘capable of’ limitation and that such a recitation that an element is ‘capable of’ performing a function is not a positive limitation but only requires the ability to so perform. It is reasonable to expect the outermost thermoplastic resin film of Akao is printable in any mode of electrophotography, sublimation thermal transferring, melt thermal transferring, direct thermal transferring or inkjet printing.

Concerning claims 21-28, Akao discloses a laminated structure (column 1, lines 5-9) which is construed as having the form of a card, security, certificate, bill, ticket, check, license or label (Figures 7 and 20).

In all of the above mentioned claims, the instant invention includes the preamble language of, "a forgery-preventing film". Although the instant preamble has been considered, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the preamble merely recites the intended use of a structure, and the body of the claim is able to stand alone; therefore, although the preamble has been considered, the preamble language has not been accorded patentable weight.

***Claim Rejections – 35 USC § 102(b)***

11. Claims 1-3, 6-7, 13-14 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Akao (U.S. 4,661,401).

Akao discloses a film having two thermoplastic resin film layers (2,3) attached to both faces of a light shielding layer (1) (column 2, lines 16-21, column 3, lines 48-54) where at least one layer of the overall laminate has light-shielding properties (column 7, lines 19-22 and Figure 5) where column 2 ,lines 26-27, discloses numbers within a

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circle mean the layers contain light-shielding materials, which includes layer 1 in Figure 5. In claim 1, the phrase, "for forgery prevention" is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Concerning claims 2-3 and 7 because Akao discloses a structure in which a thermoplastic resin film is attached to both faces of a light shielding layer, it is inherent for the light shielding layer to have shading that is invisible by reflected light but visible by transmitting light and for the light part of the material to have a dot ratio of from 5-70 percent. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In *re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of a newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. Additionally, anticipation by a prior art reference does not require that the reference recognize the inherent properties that may be possessed by the prior art reference. See *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633 (Fed. Cir.) (1987).

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Concerning claim 6, the light shielding properties may be applied by printing (column 7, lines 30-32).

Concerning claims 13-14, one of the two thermoplastic sheet layers is applied with a thermoplastic adhesive layer (4) (column 6, lines 35-37), where the adhesive layer is construed as a first thermoplastic layer and the flexible sheet layer (2 or 3) it is attached to is construed as an additional thermoplastic layer, which can comprise polyester or polyethylene terephthalate (column 4, line 58 through line 20).

Concerning claim 19, the film of Akao is laminated (column 1, lines 5-7 and 33-34). In all of the above mentioned claims, the instant invention includes the preamble language of, "a forgery-preventing film". Although the instant preamble has been considered, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the preamble merely recites the intended use of a structure, and the body of the claim is able to stand alone; therefore, although the preamble has been considered, the preamble language has not been accorded patentable weight.

***Claim Rejections – 35 USC § 103(a)***

12. Claims 4-5, 8, 11-12, 18 and 21-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akao (U.S. 4,661,401).

Akao is relied upon for claim 1 as above. Akao does not disclose shading percentage of the light shielding material or light transmittance as disclosed in claims 4-5 and 8. Although Akao does not specifically disclose the proportion of the shading percentage of the light shielding material or light transmittance, shading and light transmittance are an optimizable feature. It would have been obvious to one of ordinary skill in the art to optimize the shading of the light shielding material and light transmittance because discovering the optimum or workable range involves only routine skill in the art. The light shielding material shading and transmittance directly affects the aesthetics of the multilayer material. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215. Additionally, because a metal foil light shielding layer may be deposited on one or more of the layers (column 10, lines 35-40), it is reasonable to conclude a darker shaded, where any shading would be considered darker, would include at least 90 percent darker shading. Because shading does not necessarily inhibit all light transmittance, it is also reasonable to expect less than or about 5 to 12 percent light transmittance from the multilayer structure, which is similar to the structure that is claimed.

Concerning claims 11-12, a light shielding layer comprising aluminum is deposited on a thermoplastic resin film (column 7, lines 19-32). In claims 11 and 12, the

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phrases, "formed by applying from 2 to 10 g/m<sup>2</sup> of an adhesive that contains from 5 to 75 weight percent of white filler and/or colored pigment" and "vapor deposited" introduce process limitations to the product claims. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given little patentable weight in product claims.

Concerning claim 18, the phrase, "outermost thermoplastic resin film is printable in any mode of electrophotography" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. It is reasonable to expect the outermost thermoplastic resin film of Akao is printable in any mode of electrophotography, sublimation thermal transferring, melt thermal transferring, direct thermal transferring or inkjet printing.

Concerning claims 21-28, Akao discloses a laminated structure (column 1, lines 5-9) which is construed as having the form of a card, security, certificate, bill, ticket, check, license or label (Figure 4).

In all of the above mentioned claims, the instant invention includes the preamble language of, "a forgery-preventing film". Although the instant preamble has been considered, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body

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of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the preamble merely recites the intended use of a structure, and the body of the claim is able to stand alone; therefore, although the preamble has been considered, the preamble language has not been accorded patentable weight.

### **Response to Arguments**

13. The rejection made under 35 U.S.C. 102(e) as being anticipated by Takahashi et al (U.S. 6,562,454) is withdrawn due to Applicant perfecting the foreign priority filing date of JP 215783/2001.

The rejection made under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al (U.S. 6,562,454) is withdrawn due to Applicant perfecting the foreign priority filing date of JP 215783/2001.

### **Conclusion**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-

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272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks, can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Lawrence Ferguson/  
Patent Examiner, Art Unit 1794

/KEITH D. HENDRICKS/  
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